Applicant has amended the Claims in the instant case to overcome the Examiner's objections and now believes them to be in condition for allowance. Specifically, Applicant has included a specific step of transforming the data from one state (risk category information) to another state (a composite score). Moreover, manipulation of the data is provided for through the steps of grouping it into categories and comparing each risk factor and each category to a preset standard.

Also post-computer process activity is found in Claims 7 and 17.

In addition, Claim 19 has been added and is directed to a computer as disclosed within the specification.

Examiner has taken the position that Claims 1-18 are unpatentable over DeTore et al. in view of Robinson. It is the examiner's further position that DeTore et al. discloses a method of interacting with a computer by entering data from one or more sources into the computer with the computer having been preprogrammed such that the data is organized by one or more pre-determined risk factors. Evaluating the data by comparing it to a pre-set standard, and computing its score which represents a relative degree of strength associated with any undertaking to detect risk. However, applicant's method differs in that not only are risk factors compared to a pre-set standard, but in addition the risk factors are grouped into categories, and each category is compared to a pre-set standard. It is the second act of comparing categories as well as comparing risk factors (elements of information of DeTore et al.) which DeTore fails to teach or even suggest. Thus, when applicant computes a score by transforming the data into a composite score, he has done so in a two-step consideration, operating on what would be the equivalent presumably, of DeTore's information in database twenty.

The examiner admits that DeTore does not teach the claimed step for commercializing intellectual property in determining a probable success factor for undertaking the lawsuit involved in intellectual property as specified in claims 11, 12, and 13, but suggests that Robinson supplies the needed teachings. Applicant respectfully disagrees in that neither the Robinson abstract Lines 1-9 nor the Robinson article itself teaches or even remotely suggests evaluating the strength of a specific intellectual property and determining a probable success factor. Robinson directed comments toward the possibility of finding coverage under the standard comprehensive general liability insurance policy (as it was then known) to defend and indemnify a holder of such a policy against lawsuits brought by the owner of such intellectual property. Applicant finds no mention of determining a probable success factor for undertaking a lawsuit in the cited abstract. In fact, if Robinson's teaching were to be followed, the lawsuit would be brought by the insured against his carrier alleging a duty to defend. Robinson simply does not discuss what would be the case in chief, i.e. an intellectual property holder suing an insured, much less does Robinson discuss probable success factor for undertaking such a lawsuit or the commercialization of the intellectual property, or any other reason.

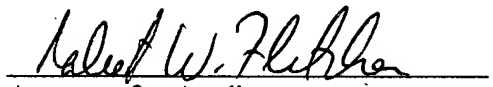
Moreover, as to Claim 3, DeTore et al. does not teach the specifically cited pre-determined risk factors, namely technical orientation, technical review, preliminary assessment, patent study, market identification and analysis, industry intelligence. DeTore simply does not indicate even an awareness of such categories, much less specifically organizing data into them.

Also, with respect to Claims 4-7 and 14-18, applicant disagrees with the Examiner's characterization of the teaching of DeTore in Column 1 Line 66- Column 2 Lines 1-15. DeTore is making specific reference to his first database, which is information collected from the entity to be insured and other sources. He then refers to means for correlating elements of information from the first database, which elements he later refers to as problems, and corresponding elements of information in the second database, which he refers to as impairments, and it is the correlation of problem with impairment that in fact enables him to assign a weight to that problem, and storing the weight following entry thereof and finally determining a risk classification from the weights assigned to the elements of information in the first database. There is no grouping of elements of information from the first database into categories. It is a correlation of problem to impairment, which is completely different from applicant's claimed method.

Moreover, DeTore does not teach a probable success factor for a lawsuit, but rather teaches or suggests a mortality ratio, i.e. the probability an individual will die. DeTore then suggests that using a proper risk classification, the billing of premiums will be appropriate in amounts to assure profitability at the levels expected from the actuarial pricing assumptions employed. This is not the same as predicting the probability of successfully commercializing intellectual property, and there is no suggestion in either Robinson, DeTore, or any other reference cited by the Examiner that the DeTore methodology be used in such a way.

In view of the foregoing, amended Claims and remarks, applicant believes that all of the Claims presented are now in condition for allowance, and respectfully requests such action.

Respectfully Submitted,



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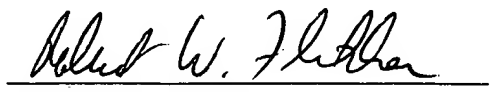
CERTIFICATE OF MAILING

I hereby certify that this Response to the Office Action dated January 23, 1998 for U.S. Serial No. 08/581,992 filed 1/02/96, Entitled: Method for Determining the Risk Associated With Licensing or Enforcing Intellectual Property, is being deposited with the United States Postal Service with first class postage thereon in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231 on May 26, 1998.



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